

REMARKS

The Examiner is thanked for the very thorough and professional Office Action. Pursuant to that action, Claim 11 has been cancelled, and Claims 20 and 25 have been amended to more definitely set forth the invention, provide proper dependency and obviate the rejections. Support for the amendment of Claims 20 and 25 can be found in the Specification on page 13, lines 17-25 and page 14, lines 1-3. In addition, new Claims 26-32 are presented. Support for Claim 26 can be found in the Specification on pages 23-27, and support for new claim 32 can be found in original claim 11. The present amendment is deemed not to introduce new matter. Claims 1-10 and 12-32 are in the application, Claims 1-10 and 12-16 having been withdrawn from consideration as being directed to a non-elected invention, and Claim 11 having been canceled.

Reconsideration is respectfully requested of the objection to Claim 25. The term "applying" has been amended and it is therefore believed that the objection is now moot. Withdrawal of the objection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 20 and 25 as being indefinite. Both Claims 20 and 25 have been amended to set forth with particularity the hydroxycarboxylic acid derivatives. In view of this amendment, it is respectfully submitted that the rejection is now moot and withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 17 and 19 under 35 U.S.C. § 102(a) as being anticipated by Katsumata, et al.

The issue presented in this rejection is whether the Examiner has erred in refusing to give any weight to the expression "a method of treating environmental stress due to exposure of skin to

**DOCKET NO. TOS-125-USA-CIP**

automobile exhaust gases, comprising---". Applicants respectfully submits that the answer to this question is emphatically in the affirmative because the claims presented in this application are "process claims", not composition claims as assumed by the Examiner.

The Examiner's treatment of the claims in this case as though they were directed to a composition is apparent from the Examiner's statement in the rejection that "A chemical composition and its properties are inseparable". It is respectfully urged that all of the claims presented are process claims directed to a method of treating environmental stress due to exposure of skin to automobile gases. In this regard, it is respectfully submitted that neither Katsumata, et al. nor any other reference of record teaches that exposure of the skin to automobile exhaust gases causes environmental stress to the skin. On the contrary, that teaching or suggestion comes only from the present application and constitutes an important element or aspect of the present invention, i.e., a recognition of the problem to be solved.

It is thus apparent that none of the references of record even recognize the problem of environmental stress, much less any method of solving this problem. Moreover, there is no disclosure whatever in Katsumata, et al. nor any other reference of record of applying to the skin a liniment comprising thiotaurine so as to treat environmental stress due to exposure of the skin to automobile gases.

The courts have consistently held that a process claim may be allowed confined to a new use, provided the other standards of patentability such as non-obviousness are met. Mehl/Biophile International Corp. v. Milgram, 8 Fed Supp 2d 434, 446, 47 USPQ 2d 1248, 1257 (D.N.J. 1998) citing Treaties; "Applying an old process to a new use can be patented only if it survives the other

DOCKET NO. TOS-125-USA-CIP

standards for patentability."

See also In re Schoenwald, 964 Fed 2d 1122, 22 USPQ 2d 1671 (Fed Cir 1992); and Loctite Corp. v. Ultraseal, Limited, 781 Fed 2d 861, 875, 228 USPQ 90, 99 (Fed Cir 1995), wherein the court indicated that:

"Even if a composition is old, a process using a known composition in a new and unobvious way may be patentable."

This view regarding the patentability of a new use of an old product is confirmed by the trilogy of cases of Tolfree v. Wetzler, 25 Fed 2d 553 (3d Cir. 1928); Ex parte Muller, 81 USPQ 261 (Pat. Off. Bd. App. 1947); and Ex parte Wagner, 88 USPQ 217 (Pat. Off. Bd. App. 1950). Under these decisions, a process may be allowed confined to the new use of an old composition, provided the other standards of patentability such as non-obviousness are met.

In the present case, it is respectfully submitted that the other standards of patentability, i.e., non-obviousness, have been met since there is no teaching whatever in any of the prior art of record (1) that exposure of the skin to automobile gases causes environmental stress, or (2) that this stress can be treated by applying a liniment to the skin comprising thiotaureine and/or a hydroxycarboxylic acid and/or its derivatives. On the contrary, this teaching comes solely from the present application and is believed to demonstrate the non-obviousness of the present invention. In view of the foregoing, it is respectfully submitted that the rejection fails in view of the above authorities. Consequently, the Examiner would be justified in no longer maintaining the rejection. Withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 11, 17, 20 and 23 under

DOCKET NO. TOS-125-USA-CIP

35 U.S.C. § 102(e) as being anticipated by Tominaga, et al.

The same issue and case law discussed above is applicable to the rejection based on the Tominaga, et al. reference. Tominaga, et al fails to recognize that exposure of the skin to automobile exhaust gases causes environmental stress. Further, there is no recognition in Tominaga, et al. that environmental stress can be treated by applying to the skin a liniment comprising thiotaureine and/or a hydroxycarboxylic acid and/or its derivatives. For these reasons, it is respectfully submitted that the rejection fails, as a matter of law, in view of the above authorities. Consequently, the Examiner would be justified in no longer maintaining the rejection. Withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 17-19 under 35 U.S.C. § 103(a) as unpatentable over Katsumata, et al. As pointed out above, there is no teaching or suggestion whatever in the Katsumata, et al. reference that exposure of skin to automobile gases causes environmental stress, nor is there any teaching of a method of treating the environmental stress by applying to the skin a liniment comprising thiotaureine. Absent such a teaching, it is respectfully submitted that it is entirely non-obvious to carry out the process called for in the claims herein in view of the above authorities. Consequently, the rejection fails, as a matter of law, for the same reasons discussed above with respect to the rejection under 35 U.S.C. § 102. Consequently, the Examiner would be justified in no longer maintaining the rejection. For these reasons, withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 11 and 17-25 under 35 U.S.C. § 103(a) as being unpatentable over Tominaga. The Tominaga reference like Katsumata, et

**DOCKET NO. TOS-125-USA-CIP**

al. fails to recognize the problem in this case, i.e., that exposure of skin to automobile exhaust gases causes environmental stress, nor is there any teaching in Tominaga that such environmental stress can be treated by applying to the skin a liniment comprising thiotaurine. Consequently, it is respectfully submitted that the lack of recognition in the prior art of this problem or method of solving the problem is strong evidence of the non-obviousness of the process now called for in the claims herein. Consequently, the rejection fails as a matter of law, in view of the authorities discussed above. For these reasons, the Examiner would be justified in no longer maintaining this rejection. Withdrawal of the rejection is accordingly respectfully requested.

The arguments applied with respect to the Katsumata, et al. and Tominaga are likewise applicable to newly added Claims 26-31.

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance and early action and allowance thereof is accordingly respectfully requested.

In the event there is any reason why the application cannot be allowed at the present time, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems.

Respectfully submitted

TOWNSEND & BANTA



Donald E. Townsend  
Reg. No. 22,069

Date: December 19, 2003

**DOCKET NO. TOS-125-USA-CIP**

TOWNSEND & BANTA  
601 Pennsylvania Ave., N.W.  
Suite 900, South Building  
Washington, D.C. 20004  
(202) 220-3124